REMARKS

By this amendment, applicant has cancelled claims 6, 9 - 11 and has amended claims 7, 8, 12, 14, 15 and 19 and presents new claims 23 - 28. The claims remaining in the application are:

7 - 8, 12 and 14 - 28.

Re-examination and reconsideration of the application is respectfully requested.

New claim 23 sets forth a method for playing a wagering game which includes the feature of the player making a wager to play each of a series of hands. For each hand of play individual indicia (not complete outcomes) are randomly selected and displayed from the inventory of indicia to define a winning or losing outcome for the hand. The selected and displayed indicia are depleted from the inventory of indicia available for play of the next hand. Prior to commencement of the next hand of play the method includes displaying to the player information regarding any possible winning outcomes eliminated by depletion of indicia.

Applicant submits that the cited art does not disclose or suggest the features of claim 23. Fuchs discloses a game where the player is presented with a first set of randomly selected symbols from which the player can hold symbols over to the next game. The game processor displays, based upon which of the symbols are initially displayed and those the player holds, the possible winning outcomes the player may obtain and the probability for obtaining each. (Fuchs, Col. 6, lines 10 - 36) for that hand of play. Fuchs does not disclose or suggest displaying, prior to commencement of the next hand, those winning outcomes which have been eliminated by depletion. According to the applicants invention of claim 23, if one or more prior hands have

depleted all of the Aces, there would be displayed prior to commencement of the next hand information that a Royal Flush is no longer available. As stated above, Fuchs requires a player to be "dealt" and hold certain indicia (after play has begun for the hand) before display of the probabilities of the outcomes is displayed. That is, prior to the play of next hand (before the deal) the player would not know which outcomes are no longer available. Further, if the player were dealt a hand of 7♡ 4♣ 9♣ 4◇ 2◇ in Fuchs he would have no way of knowing is the Royal Flush has been eliminated since none of the hold decisions would prompt Fuchs to display this information in that there are no cards in the initial holding which could be included in a Royal Flush. Further, if the player decides not to hold any cards of the initial holding, Fuchs again would not display which outcomes have been eliminated. For example, with the hand of 7♡ 4♣ 9♣ 4◇ 2◇ and the player decides to hold none of the cards, NO information would be imparted to the player whether any fours of a kind, straight flushes, straights, full houses or the like have been eliminated due to inventory depletion. This shows that (1) there is no prior knowledge of eliminated outcomes and the player must make a hold decision before any information in Fuchs is imparted to the player.

It is submitted that Fuchs teaches away from the feature of providing the player with "pre-deal" information as to depletion - eliminated winning outcomes. Fuchs instead requires the hand to be initially displayed and the player make their hold decisions before the display of outcome probabilities.

Still further, there is no disclosure in Fuchs of elimination of winning outcomes by depletion. Fuchs, in fact, teaches away from this feature by providing:

" In order to ensure that an adequate number of game symbols is available at all

times, provision can be made that after a certain number of games or after a certain number of game symbols have appeared, **the number of available game symbols can be added to in a random fashion or predetermined fashion...**" Col. 10, lines 1 - 6.

By adding symbols and not disclosing the complete elimination of winning outcomes by depletion, it is submitted that Fuchs does not disclose and teaches away from outcome elimination due to depletion or the display of information, prior to the start of the next hand, as to which winning outcomes have been eliminated from play by depletion.

In Richardson, the player is selecting "tickets" from a predetermined ticket set. As is known in the pull tab art to which Richardson is directed, the ticket set includes a predetermined number of tickets, e.g. 500 tickets, and each ticket has printed thereon a winning or losing result much like a scratch-off lottery ticket. The distribution of winning versus losing outcomes and the prizes for winning outcomes is predetermined such that the sale of the ticket set for the play of the game can produce a profit. Thus, for example, if there are 500 tickets in the pull -tab ticket set, and each ticket sells for $1, the sale of all tickets would bring in $500. To turn a profit, the sum of all winning outcome awards would be less than $500. Thus, the only thing in Richardson that is random, is the selection of a ticket bearing the result from the ticket set which is akin to pulling a ticket from bowl containing all tickets. The outcome for that selected ticket is not generated by the random selection of individual indicia since the symbol combinations printed (or electronically stored, for that ticket are predetermined and

were long ago printed on or determined (stored in memory) for the ticket and were chosen to conform to the profit criteria described above. Thus individual indicia the outcome (ticket) are NOT randomly selected and displayed and cannot be depleted. An example to illustrate the difference is a slot machine versus a scratch - off lottery ticket. In operation of a slot machine, each reel acts to randomly select and display a symbol at a pay line. If the individual symbols selected by the reels and displayed on the pay line are a winning combination, the player gets an award. If the combination is a losing combination, the player loses. By knowing the distribution of the symbols on the reels, each winning outcome can be statistically calculated. According to a slot machine, a player could hit the major jackpot on sequential spins. That is, if the player hits the jackpot, the jackpot symbols and the jackpot outcome is not eliminated from the slot machine. It is possible for a player playing a slot machine to play 100 spins and not win anything, since he may not obtain a winning a combination of the individually selected and displayed symbols.

A scratch-off lottery ticket is much different from slot machine. Each ticket group includes a predetermined number of tickets, e.g. 10,000 tickets. When the tickets are printed, they are printed so as to define, according to the theme or approach of the lottery, a winning or losing prize result. By setting the prizes to be awarded over the sale of the 10,000 tickets, the game profit can be defined by simple multiplication and subtraction. Unlike a slot machine, for a lottery game such as described in Richardson, no analysis is required to determine what the probabilities are of certain symbol combination being obtained by random selection of individual symbols. Further, if the lottery ticket set has only one jackpot ticket, once that ticket is sold no one can ever buy

a ticket with another jackpot for that game (often referred to as a deal).

While the Examiner has relied on Richardson for teaching re-shuffling by the player of the deal (ticket) set to reconstitute the same. It is respectfully submitted that confusion has resulted from the use of the word "deal" in Richardson. What is meant by Richardson's reference to the player requesting a new deal is that the player can request that the tickets be draw from a different ticket set. It should be understood that in Richardson, results reflected by the tickets are bought and revealed. There is no random selection of individual indicia (like a slot machine) to produce a winning or losing outcome. Were a player, in Richardson, able to re-configure a ticket set, the profit and loss from the set could never be determined. For example, if the Richardson ticket set (deal) had 10,000 tickets, half were sold but 75% of the prizes had been claimed, how would the deal (ticket set) be reconfigured (re-shuffled) by the player? If the deal would be reset the vendor of the game would lose money since 75% of the prizes have been awarded but only half of the tickets sold. Thus the reference to the player in Richardson requesting a "new deal" would be understood by those skilled in the art as the player requesting that the tickets be drawn from a new ticket set (i.e. a new deal.

Still further, Richardson does not disclose individual indicia selection and depletion. Nor does he disclose or suggest displaying, prior to the next hand of play, which outcomes have been eliminated by individual symbol depletion.

The Examiner has also cited Kinoshita et al for disclosing a pay table wherein outcomes have been eliminated. Kinoshita, like Fuchs, discloses a game which displays before the cards are dealt the odds for a player to obtain a winning outcome.

Since Kinoshita et al does not disclose inter - hand inventory depletion, prior to the deal it would NOT show any eliminated outcomes. See Kinoshita et al FIG. 8(a) where prior to the deal all outcomes are possible. After the initial deal and based upon the player's hold decisions, certain winning outcomes become impossible. See Kinoshita et al FIGS. *8(b) - (c) where the player has held two pair. Thus Kinoshita et al teaches away from displaying prior to the deal of the next hand outcomes which have been eliminated by depletion since (1) Kinoshita et al does not teach depletion and, as a result, (2) prior to the deal of the next hand ALL outcomes are possible.

In view of the foregoing, it is submitted that the cited art does not disclose or suggest the features of claim 23. None disclose displaying outcomes eliminated by depletion of individual indicia prior to the deal of the next hand. Allowance of claim 23 is respectfully solicited.

As for obviousness, the Examiner bears the initial burden of factually supporting a prima facie case of obviousness. MPEP § 2142. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious in light of teachings of the references. MPEP §2142.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation (either in the references themselves or in the knowledge generally available to one of ordinary skill in the art) to modify the reference teachings. The prior art reference (or references when combined) must teach or suggest **all** the claimed

limitations. MPEP §2143. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to those skilled in the art. *In re Fine* 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.01. A statement that modifications of the prior art, to meet the claimed invention, would have been well within the ordinary skill in the art at the time the claimed invention was made, is not sufficient to establish *prima facie* obviousness without some objective reason to combine the teachings of the prior art. MPEP §2143.01. Further, if the proposed modification of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are insufficient to render the claims *prima facie* obvious. MPEP §2143.01. Further there must be some showing of a motivation or teaching of the desirability of making the specific combination that forms the claimed invention. *In re Oetiker 25 USPQ2d 1443 (Fed. Cir. 1992).* This requirement cannot be satisfied by broad conclusory assertions since the same do not qualify as evidence. *In re Dembicziak, 50 USPQ2d 1614 (Fed. Cir. 1999).* The Patent Office is not permitted to make assumptions as to basic knowledge simple alleged to be possessed by all those of ordinary skill in the art and then to rely on this assumption as a substitute for the required production of evidence showing motivation. *In re Zurko, 59 USPQ2d 1693 (Fed. Cir. 2001).* The mere allegation of the existence of common knowledge in the art does not make it so and thus evidence of such knowledge is required to be shown. *In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002).*

None of the cited references teach the feature of displaying, before the deal of the next hand, outcomes which have been eliminated by depletion of individual indicia. None of the references teach a combination which includes this feature.

Allowance of claim 23 is requested.

Claims 7 and 8 have been amended to depend from claim 23. Applicant submits that in view of the arguments above with respect to claim 23, claims 7 and 8 are now in condition for allowance. In regard to claim 8, where the data is randomly arranged in serial order, the Examiner has stated that such an arrangement would be obvious referencing Fuchs at Col. 4, lines 45 - 59. Applicant submits that disclosing setting the symbol data in a list, as disclosed in Fuchs, does not disclose or suggest arranging the data in a random manner and serially selecting the data. The Patent Office is not permitted to make assumptions as to basic knowledge simple alleged to be possessed by all those of ordinary skill in the art and then to rely on this assumption as a substitute for the required production of evidence showing motivation. *In re Zurko, supra.* The mere allegation of the existence of common knowledge in the art does not make it so and thus evidence of such knowledge is required to be shown. *In re Lee, supra.* Fuchs does not disclose randomizing and serializing the data and then selecting the data in serial order.

New claim 26 recites an electronic device along the lines of new claim 23. This claims recites the feature of the processor configured to control the display to display, prior to the play of the next hand, any scheduled winning outcomes which have been eliminated by depletion. For the reasons advanced above, allowance of claim 26 is

solicited.

Claim 12 has been amended to depend from claim 26 to recite the display of indica in a matrix. None of the cited references disclose this feature. For this, and the reasons set forth above, allowance of claim 12 is requested.

Claim 14 depends from claim 12. For the reasons advanced above, allowance of claim 14 is requested.

Claim 15 has been amended along the lines of claim 23. For the reasons advanced with respect to claim 23, allowance of claim 15 is respectfully requested.

Claims 16 - 18 depend from claim 15. In view of the arguments made with respect to claim 15 (and 23) allowance of claims 16 - 18 is requested. With reference to claim 16, this claim further recites that the player has the option to reconstitute the inventory. The Examiner has noted that Fuchs does not teach reconstitution of game symbols and relies upon Richardson as disclosing a game where a set of individual symbols can be reconstituted on command. Applicant respectfully refers the Examiner to the discussion of Richardson above. Richardson is not an individual symbol game but instead is a game where complete *outcomes* are drawn from an inventory of *outcomes*. Since Richardson's data base includes outcomes, it teaches away from reconstitution of individual symbols. Applicant also respectfully submits that any suggestion of combining the teachings of a pull tab game (Richardson) with Fuchs is only as a result of hindsight reconstruction of the invention. Neither reference discloses reconstitution of game symbols for a game of the type where individual symbols are randomly selected to define outcomes.

This teaches away from reconstitution of the inventory to its original composition

and supports applicant's interpretation that the display of Fuchs FIG. 7b is just that, simply a display of what the full inventory was and is not a disclosure or suggestion of player commanded reconstitution.

Claim 19 has been amended along the lines of claim 26. For the reasons advanced above, allowance of claim 19 is also requested.

Claims 20 - 22 depend from claim 19. For the reasons advanced above, allowance of these claims is also requested.

Claims 27 - 28 depend from claim 26. For the reasons advanced with respect to claim 26 (and by reference claims 23), allowance of these claims is also requested.

Addressing the Examiners points at page 7 of the Office Action directed to the Applicants contentions as to the combination of Fuchs and Richardson, the Examiner notes that, in regards to Fuchs "no player would continue to play with the majority of prizes gone thus one would turn to Richardson to solve the problem". First Fuchs (and for that matter Kinoshita) disclose showing the player his chances for obtaining a winning outcome based upon (1) the cards (symbols) dealt and (2) what the player decides to hold. Neither shows, prior to the original deal, what winning outcomes have been eliminated, by individual symbol depletion. With reference to Fuchs, the Examiner's position underscores the fundamental difference between Richardson and Fuchs. In Fuchs, the only way a player will know is a prize is gone would be based upon the deal and hold decisions (remember, Fuchs teaches re-stocking to make sure there are an adequate number of symbols) clearly suggesting that no outcome would be eliminated. It may become less likely and that information would be imparted to the player IF the player had a corresponding deal and made the appropriate hold decision.
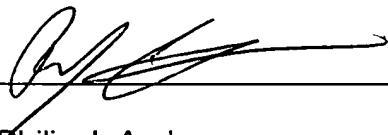
CONCLUSION

For the reasons advance above, it is submitted that all pending claims are in condition for allowance. Allowance of all pending claims is solicited. The undersigned requests a telephone interview to discuss any remaining issues.

Respectfully submitted,

ANDERSON & MORISHITA, LLC

Dated: *May 27, 2004*   By: _____

Philip J. Anderson
Registration No. 29,887
Anderson & Morishita, LLC
2725 S. Jones Blvd
Suite 102
Las Vegas, NV 89146
(702) 222-2113 Phone

G:\Karaway\01-01 Amendment 3 Rev 2.wpd